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GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LAMB, BRENDA A	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/619,424

Filing Date: July 16, 2003

Appellant(s): KURTZ ET AL.

Neil F. Greenblum
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/05/2007 appealing from the Office action mailed 7/27/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

01/98585

WO

12-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/98585.

WO '585 as shown in figure 2 teaches a device for impregnating a web with an impregnating agent comprising the following elements: a coating device structured and arranged to apply the impregnating agent to the web; and a wide nip calendar located, with respect to a web travel direction, before the coating device, the wide nip calendar comprising a circulating jacket and a back pressure element (an soft elastic belt passing over a stationary shoe) arranged to form a wide nip calendar (see page 7 lines 11-18). WO '585 teaches at page 8 line 32 to page 9 line 5 the fibers are deformed by precalendering and therefore the web compression as a result of the taught deformation of the fibers is still present when the web enters the coating device. WO '585 teaches at page 7 lines 31-32 and the shoe is adjustable to change the pressure profile and nip length. WO '585 fails to teach the wide nip calender provides for elastic compression of the web. However, it would have been obvious that the WO '585 wide nip calender in

the WO '585 device is capable of elastic compression dependent on the pressure profile and nip length of the wide nip calender which is adjustable via the shoes in the wide nip calender as taught by WO '585 and such compression is capable of being present when the web enters the coating device, spaced a distance from the recited calender,

dependent on amount of resiliency of the web and degree of compression of the web.

With respect to claim 2, WO '585 apparatus is capable of applying an impregnating agent which is comprised of a starch solution or other coating agents commonly used in paper upgrading since WO '585 teaches every structural element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 3, WO '585 apparatus is capable of applying an impregnating agent which is comprised of a starch size since it teaches every structural element to the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 4, WO '585 apparatus is capable of

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applying an impregnating agent to a web which is comprised of one of a paper or cardboard web since WO '585 teaches every structural element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 5, WO '585 apparatus is capable of applying an impregnating agent to a web wherein the web has a basis weight over 40g/m since WO '585 teaches every structural element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 6-7, WO '585 is silent as to web processing devices being provided between the wide nip calender and the coating device thereby reading on the negatively claimed limitation that no web processing devices are provided between the wide nip calender and the coating device. Further, WO '585 shows in Figure 1 at least one guide device is arranged between the wide nip and the coating device. With respect to claim 8-10, WO '585 teaches the wide nip calender is comprised of a heating device, roll 1, which is a back pressure element

having a surface structured and arranged to guide the web through the wide nip, and the surface having a temperature adjustable to within the scope of the claim. With respect to claim 11, WO '585 teaches the coater is a film press. With respect to claim 14, WO '585 teaches the wide nip calender is adjustably heated to at least the plasticizing temperature of the fibers of the web (see page 8 lines 1-7 of WO '585). With respect to claims 12 and 15, WO '585 teaches at page 9 lines 7-8 a drying area which broadly reads on area whereby the web is dried which is arranged after the coating device and a reeling device wherein the drying area and a reeling device are each arranged downstream of the coating device. Further, WO '585 fails to teach a glazing device arranged between the coating device and the reeling device thereby reading on the negative limitation of no glazing device arranged between the coating device and the reeling device. With respect to claim 13, WO '585 wide nip calender includes a heating means for heating the surface of the roll 1 in the wide nip calender to at least 250 degrees centigrade such that the wide nip calender is capable of being heated to a temperature higher than the drying area. With respect to claim 33, as discussed above, WO '585, as shown in figure 2, teaches a device for impregnating the web with an impregnating agent comprising the following elements: a coating device structured and arranged to apply the impregnating agent to the web; and a wide nip calendar located, with respect to a web travel direction, before the coating device, the wide nip calendar comprising a circulating jacket and a back pressure element, a belt passing over a stationary shoe, arranged to form a wide nip calendar (see page 7 lines 11-18). Further, WO '585 coater reads on a film press since WO '585 teaches a film or

layer of coating is applied onto the web as the web travels through a nip N' of the rollers. WO '585 fails to teach the wide nip calender provides for elastic compression of the web. However, it would have been obvious that the WO '585 wide nip calender in the WO '585 device for impregnating a web with an impregnating agent is capable of elastic compression dependent on the pressure profile and nip length of the wide nip calender which is adjustable via the shoes in the wide nip calender as taught by WO '585.

(10) Response to Argument

Appellant's argument that WO '585 fails to disclose the distance between the pre-calender and coater is such that elastic compression of the web is still present when the web enters the coating device is found to be non-persuasive.

First of all, it is noted by the examiner that claim 33 is silent as to the claimed limitation that a distance between the coating device and the wide nip calender is such that web elastic compression of the web by the wide nip calender is still present when the web enters the coating device rather only requires that the wide nip calender be capable of elastic compression of the web. Second of all, the wide nip calender as shown in Figure 2 of WO '585 is positioned a distance from coating device with a web guide device arranged therebetween. The WO '585 wide nip calender is capable of providing elastic compression of the web such the recited compression is present when the web enters the coating device, spaced a distance from the wide nip calender, dependent on the pressure profile and nip length of the wide nip calender which is

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taught by WO '585 to be adjustable via shoes in the wide nip calender as well as dependent on properties of the web itself (amount of resiliency of the web).

Applicant's argument that WO '858 requires permanent not elastic compression of the web with WO '858 teaching at page 1 lines 17-19 that calendering serves to press the paper to a final thickness is found to be non-persuasive. As discussed above, WO '585 teaches as shown in figure 2 a device for impregnating a web with an impregnating agent which is comprised of the following elements:

a coating device structured and arranged to apply the impregnating agent to the web; and a wide nip calendar located, with respect to a web travel direction, before the coating device, the wide nip calendar comprising a circulating jacket and a back pressure element (an soft elastic belt passing over a stationary shoe) arranged to form a wide nip calendar (see page 7 lines 11-18).

WO '585 teaches at page 7 lines 31-32 that the shoe is adjustable to change the pressure profile and nip length of the wide nip calender. Further, WO '585 teaches at page 4 line 23 to page 5 line 7 the wide nip calender is capable of being operated in a manner such that the fibers in the middle in the z-direction may be left unaffected wherein the bulkiness of the paper is maintained or may be operated such that the fibers in the middle of the paper undergoes deformation especially in the case of thin paper grades which would infer to one skilled in the art that the WO '585 apparatus is capable of being operated to achieve different outcomes in regard to the web dependent on properties of the web itself entering the calendering nip. Therefore, the examiner maintains that apparatus of WO '585 is capable of elastic compression of the

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web in the calendaring nip especially given the teaching of WO '585 that fibers in the middle in the z-direction of the paper web may be left unaffected or not compressed while fibers only at the surface of the web are deformed thereby limiting compression of the web.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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